



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/547,496 04/12/00 KIMURA

S 3002/FLK

NM92/0606

ROSENMAN & COLLIN LLP  
575 MADISON AVENUE  
NEW YORK NY 10022-2585

EXAMINER

NGUYEN, W

ART UNIT

PAPER NUMBER

2832

DATE MAILED:  
06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/547,496

Applicant,  
Kimura

Examiner  
Minh D. Nguyen

Art Unit  
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 12, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

Art Unit: 2832

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 04/13/99. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

### ***Drawings***

2. Figure 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cover and a bottom must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

Art Unit: 2832

in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant fails to adequately disclose how the core has a pair of first and second lateral walls and a cover and a bottom.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, applicant should clarify the structure of the first and second lateral walls and the cover and bottom portion of the core. From the figures, it appears that the core is formed of one piece. Applicant should clarify. In lines 7 and 10, the term “substantial” is a relative term. In lines 7-9, the opened region in “the cover” is unclear. Applicant should clarify. Applicant should clarify the specific orientation of the *bobbin* [11]. In lines 13-14, the specific location of the electrodes is unclear. Applicant should clarify. Claims 2-4 inherit the defects of the parent claim.

Regarding claim 2, there lacks sufficient structure to support the functional language of “a sealant being *charged through* the through holes... and a downside thereof.”

Regarding claim 3, there is no antecedent basis for “said winding.” In line 3, there lacks sufficient structure to support the functional language of “thermal-compression bonding.”

Art Unit: 2832

Regarding claim 4, there is no antecedent basis for "said winding." In line 3, there lacks sufficient structure to support the functional language of "thermal-compression bonding."

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 3, as best understood in view of the rejection under 35 U.S.C. 112 first and second paragraphs, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui et al. [US 4,352,080] in view of Tsunemi [US 6,157,283].

Mitsui et al. discloses a core for a choke coil comprising:

- bottom and cover portions [10], each having sidewalls defining an *opened region* [see figure 9] forming a cubic shape;

- *a bobbin* [12] extending in parallel with the sidewalls; and

- windings [see column 4, lines 51-65] wound about the bobbin and connected to terminals.

Mitsui et al. discloses the instant claimed invention except for the specific electrode design for connecting the windings.

Tsunemi discloses a surface mounted type coil component for a winding connected to electrodes [38] extending along the exterior of the sidewalls.

Art Unit: 2832

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrode design of Tsunemi in the device of Mitsui et al. for the purpose of facilitating connection thereof.

10. Claim 2 and 4, as best understood in view of the rejection under 35 U.S.C. 112 first and second paragraphs, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui et al. in view of Tsunemi as applied to claim 1 above, and further in view of Sakata et al. [US 5,680,087].

Mitsui et al. in view of Tsunemi disclose the instant claimed invention except for *a sealant being charged through the through holes*.

Sakata et al. discloses a sealant [15] being *charged* about a winding structure [see figure 1].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to *charge* resin about the *opened region* of Mitsui et al.'s device, as modified, as suggested by Sakata et al., for the purpose of protecting the winding structure.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Minh Nguyen whose telephone number is (703) 308-8505.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Gellner, can be reached at (703)308-1721. The fax number for this Group is (703)305-7724.

Application/Control Number: 09/547,496

Page 6

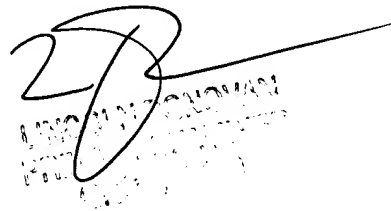
Art Unit: 2832

Any inquiry of a general nature or relating to the status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

MN

Art Unit 2832

June 4, 2001

A handwritten signature, possibly reading 'ZB', is written over a rectangular stamp. The stamp contains some illegible text, likely a date or administrative marking.